



Receipt

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Vimla Band
Serial No. : 10/021,368
Filed : December 12, 2001
Title : NES-1 POLYPEPTIDES, DNA, AND RELATED MOLECULES AND METHODS

Art Unit : 1656
Examiner : Nashaat T. Nashed

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR CORRECTED OFFICIAL FILING RECEIPT

Please correct the Filing Receipt for the above-referenced application to indicate the correct application number for the first listed priority application.

The first listed priority application number should be: **09/605,175**.

A copy of the original Filing Receipt showing the desired changes in red ink is attached for your convenience. Please supply a corrected Filing Receipt to the undersigned with respect to this application.

Also attached to evidence the correct application number is (i) a copy of the Amendment in Reply to Action submitted to the U.S.P.T.O. on August 22, 2005, which amended the specification to correct the application serial number in the priority claim (see page 2 of the amendment), and (ii) a copy of the Notice of Allowance dated September 16, 2005, in which the Examiner stated that the application has been amended as requested (see page 2 of the Notice of Allowability).

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

11/29/05
Date of Deposit

Signature

Typed or Printed Name of Person Signing Certificate

Applicant : Vimla Band
Serial No. : 10/021,368
Filed : December 12, 2001
Page : 2 of 2

Attorney's Docket No.: 00398-100005 / 105

No fee is believed to be due. If, however, there are any charges or credits, please apply them to Deposit Account No. 06-1050, referencing Attorney Docket No. 00398-100005.

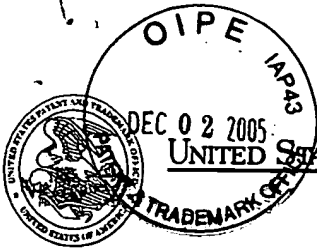
Respectfully submitted,

Date: November 29, 2005

Allyson R. Hatton
Allyson R. Hatton, Ph.D.
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21215794.doc

ALM
LLC

UNITED STATES PATENT AND TRADEMARK OFFICE

 COMMISSIONER FOR PATENTS
 UNITED STATES PATENT AND TRADEMARK OFFICE
 WASHINGTON, D.C. 20231
 www.uspto.gov

APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLAIMS	IND CLAIMS
10/021,368	12/12/2001	3736	370	00398-100005	7	13	3

RECEIVED

CONFIRMATION NO. 3165

 LEE CREWS, PH.D.
 Fish & Richardson P.C.
 225 Franklin Street
 Boston, MA 02110-2804

FEB 25 2002

FISH & RICHARDSON, P.C.
BOSTON OFFICE

FILING RECEIPT



OC000000007504395

Date Mailed: 02/20/2002

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

Vimla Band, Natick, MA;

Assignment For Published Patent Application

New England Medical Center Hospitals, Inc., Massachusetts corporation;

Domestic Priority data as claimed by applicant 09/605,175

 THIS APPLICATION IS A DIV OF 09/605,175 06/28/2000
 WHICH IS A CON OF 09/201,038 11/30/1998 PAT 6,153,387
 WHICH IS A CON OF 08/628,198 04/05/1996 PAT 5,843,694
 WHICH IS A DIV OF 08/467,155 06/06/1995 PAT 5,736,377

Foreign Applications

If Required, Foreign Filing License Granted 02/20/2002

Projected Publication Date: 05/30/2002

Non-Publication Request: No

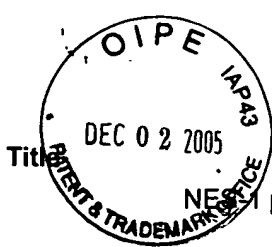
Early Publication Request: No

** SMALL ENTITY **

NO DOCKETING REQUIRED

Reviewed By Practice Systems

Initials PEC On _____



polypeptides, DNA, and related molecules and methods

Preliminary Class

600

**LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15**

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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NOTICE OF ALLOWANCE AND FEE(S) DUE

26161 7590 09/16/2005
FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER
NASHED, NASHAAT T

ART UNIT PAPER NUMBER
1656

DATE MAILED: 09/16/2005

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,368	12/12/2001	Vimla Band	00398-100005	3165

TITLE OF INVENTION: NES-1 POLYPEPTIDES, DNA, AND RELATED MOLECULES AND METHODS

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	YES	\$700	\$300	\$1000	12/16/2005

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN **THREE MONTHS** FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. **THIS STATUTORY PERIOD CANNOT BE EXTENDED.** SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,368	12/12/2001	Vimla Band	00398-100005	3165

26161 7590 09/16/2005

FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

NASHED, NASHAAT T

ART UNIT

PAPER NUMBER

1656

DATE MAILED: 09/16/2005

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 150 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 150 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571) 272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.

Notice of Allowability

Application No.

10/021,368

Examiner

Nashaat T. Nashed, Ph. D.

Applicant(s)

BAND, VIMLA

Art Unit

1656

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address–

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment filed August 25, 2005.

2. ☒ The allowed claim(s) is/are 69-75,82,83 and 100-108.

3. ☒ The drawings filed on 25 August 2005 are accepted by the Examiner.

4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of the:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.

6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.

(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached

1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.

(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)

2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____

4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material

5. ☐ Notice of Informal Patent Application (PTO-152)

6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____.

7. ☐ Examiner's Amendment/Comment

8. ☒ Examiner's Statement of Reasons for Allowance

9. ☐ Other _____.

Art Unit: 1656

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1656.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 25, 2005 has been entered.

The application has been amended as requested in the communication filed August 25, 2005. Accordingly, claims 84-95 and 109-119 have been canceled.

Claims 69-75, 82, 83, and 100-108 are pending and under consideration.

The terminal disclaimer filed on August 25, 2005 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of US patent 6,153,387 has been reviewed and is accepted. The terminal disclaimer has been recorded.


Claims 69-75, 82, 83, and 100-108 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The filing of an acceptable terminal disclaimer over US patent 6,153,387, and the deletion of claims 84-95 and 109-119 obviated all rejections of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nashaat T. Nashed, Ph. D. whose telephone number is 571-272-0934. The examiner can normally be reached on MTTF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen M. Kerr can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nashaat T. Nashed, Ph. D.
Primary Examiner
Art Unit 1656

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Vimla Band
Serial No. : 10/021,368
Filed : December 12, 2001
Title : NES-1 POLYPEPTIDES, DNA, AND RELATED MOLECULES AND
METHODS

Art Unit : 1652
Examiner : Nashaat T. Nashed

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT IN REPLY TO ACTION OF MARCH 11, 2005

Please amend the above-identified application as follows.

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

8/22/05
Date of Deposit

Signature

Chutahias
Typed or Printed Name of Person Signing Certificate

Applicant : Vimla Band.
Serial No. : 10/021,368
Filed : December 12, 2001
Page : 2 of 10

Attorney's Docket No.: 00398-100005

In the specification:

Please amend the paragraph inserted following paragraph at page 1, line 3 (between the title of the application and the "Background of the Invention") by the preliminary amendment filed December 12, 2001, as follows:

This application is a divisional application of U.S.S.N., ~~09/605,176~~ 09/605,175, filed June 28, 2000, now abandoned, which is a continuation of U.S.S.N. 09/201,038, filed November 30, 1998 (now U.S. Patent No. 6,153,387), which is a continuation application of U.S.S.N. 08/628,198, filed April 5, 1996 (now U.S. Patent No. 5,843,694), which is a divisional application of U.S.S.N. 08/467,155, filed June 6, 1995 (now U.S. Patent No. 5,736,377).

Amendments to the Claims:

This listing of claims replaces all prior versions and listings of claims in the application:

Listing of Claims:

1-68. (Canceled)

69. (Previously presented) A method of determining whether a human has a carcinoma or an increased likelihood of developing a carcinoma, the method comprising:

(a) providing a biological sample from the human, wherein the biological sample comprises a Normal Epithelial Specific-1 (NES1) gene, the expression of which is down-regulated during tumorigenic progression and the sequence of which comprises a coding sequence that encodes a polypeptide that is at least 95% identical to SEQ ID NO:1; and

(b) examining the expression of the NES1 gene in the biological sample, wherein a decrease in the expression of the NES1 gene relative to expression of a NES1 gene in a control biological sample indicates that the human has a carcinoma or an increased likelihood of developing a carcinoma.

70. (Previously presented) The method of claim 69, wherein the biological sample comprises an epithelial cell.

71. (Previously presented) The method of claim 69, wherein the biological sample comprises a breast tissue cell.

72. (Previously presented) The method of claim 69, wherein the biological sample comprises a cervical tissue cell.

73. (Previously presented) The method of claim 69, wherein the biological sample comprises a prostate tissue cell.

74. (Previously presented) The method of claim 69, wherein the expression of the NES1 gene is determined by assaying NES1 mRNA expression.

75. (Previously presented) The method of claim 69, wherein the expression of the NES1 gene is determined by assaying NES1 protein expression.

76-81. (Canceled)

82. (Previously presented) The method of claim 69, wherein the biological sample comprises a cell of the skin, large intestine, lung, liver, brain, kidney, ovary, uterus, stomach, esophagus, nasopharynx, larynx, or a glandular tissue.

83. (Previously presented) The method of claim 69, wherein the control biological sample is (a) an equivalent biological sample from an unaffected individual; (b) an unaffected biological sample of a similar tissue type from the human; or (c) a standard representing a wild-type level of NES1 expression.

84-99. (Canceled)

100. (Previously presented) A method of determining whether a human has a carcinoma or an increased likelihood of developing a carcinoma, the method comprising:

(a) providing a biological sample from the human, wherein the biological sample comprises a NES1 gene, the expression of which is down-regulated during tumorigenic progression and the sequence of which comprises a coding sequence that is at least 95% identical to SEQ ID NO:2; and

(b) examining the expression of the NES1 gene in the biological sample, wherein a decrease in the expression of the NES1 gene relative to expression of an NES1 gene in a control biological sample indicates that the human has a carcinoma or an increased likelihood of developing a carcinoma.

101. (Previously presented) The method of claim 100, wherein the biological sample comprises an epithelial cell.

102. (Previously presented) The method of claim 100, wherein the biological sample comprises a breast tissue cell.

103. (Previously presented) The method of claim 100, wherein the biological sample comprises a cervical tissue cell.

104. (Previously presented) The method of claim 100, wherein the biological sample comprises a prostate tissue cell.

105. (Previously presented) The method of claim 100, wherein the expression of the NES1 gene is determined by assaying NES1 mRNA expression.

106. (Previously presented) The method of claim 100, wherein the expression of the NES1 gene is determined by assaying NES1 protein expression.

107. (Previously presented) The method of claim 100, wherein the biological sample comprises a cell of the skin, large intestine, lung, liver, brain, kidney, ovary, uterus, stomach, esophagus, nasopharynx, larynx, or a glandular tissue.

108. (Previously presented) The method of claim 100, wherein the control biological sample is (a) an equivalent biological sample from an unaffected individual; (b) an unaffected biological sample of a similar tissue type from the human; or (c) a standard representing a wild-type level of NES1 expression.

109-119. (Canceled)

REMARKS

The present amendment is being filed together with a Request for Continued Examination (RCE). In view of the RCE, Applicant respectfully requests entry of the present amendment and any amendments previously filed but not entered.

Upon entry of the amendment submitted January 24, 2005, and the amendment presented above, claims 69-75, 82, 83, and 100-108 will be pending in the application. Claims 94 and 96-99 are canceled by the amendment submitted January 24, 2005, and claims 84-93, 95, and 109-119 are canceled by the above amendment. The specification is amended to correct typographical errors and to add a reference to a patent that issued from a related application. The attached printout from PAIR, the website of the U.S. Patent and Trademark Office, provides evidence that the error in the priority claim is typographical. The printout reports that the current application (U.S.S.N. 10/021,368) and U.S.S.N. 09/605,175 both claim the benefit of U.S.S.N. 09/201,038, which is properly cited in the priority claim. No new matter has been added by the amendments.

For the record, and in reference to #2 on form PTOL-303, the Advisory Action dated March 11, 2005 (herein, "the Advisory Action"), it is incorrect that Applicant's reply to the final Office action was filed after the date of filing a Notice of Appeal. Applicant filed a response to the final Office action on January 24, 2005, and subsequently filed a Notice of Appeal on February 22, 2005. The Notice of Appeal was received by the U.S. Patent and Trademark Office on February 24, 2005, and the present amendment and RCE are being filed within the time limit set by the Notice of Appeal.

Obviousness-type Double Patenting

In the comments attached to the Advisory Action, the Examiner states (at page 2):

Claims 69-75, and 82-95 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 10-14 of U.S. Patent No. 6,152,387 (387') for the reasons set forth in the prior Office action, mailed December 19, 2003 ...

Upon entry of the after-final amendment filed January 27, 2005, claims 69-75, 82-95 and 100-119 will remain rejected.

In response, Applicant notes that claims 84-95 are canceled by the amendment submitted January 24, 2005, and the amendment presented above. Further, Applicant submits herewith a Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c) and 37 C.F.R. §3.73(b) to overcome the rejection of claims 69-75, 82, and 83. Accordingly, this ground for rejection should now be withdrawn.

35 U.S.C. § 112, ¶ 1

Written Description: In the comments attached to the Advisory Action, the Examiner states (at pages 2-3; emphasis added):

Claim (*sic.*) 69-75, 82-95 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons set forth in the prior Office action mailed December 19, 2003.
Upon entry of the after-final amendment, this rejection will be mooted.

With the filing of the RCE, the after-final amendment should now be entered and should, as the Examiner stated, render moot the rejection of claims 69-75, 82, and 83. By way of the present amendment, claims 84-95 have been canceled. Thus, the rejection based on an alleged lack of an adequate written description should be withdrawn.

The claims that have been canceled or otherwise amended were canceled or amended solely in the interest of obtaining a Notice of Allowance. Applicant's actions are not an admission that the canceled subject matter is not patentable, and Applicant expressly reserves the right to pursue claims to the original subject matter, or to any subject matter supported by the present specification, without prejudice.

Enablement: In the comments attached to the Advisory Action, the Examiner states (page 3):

Claim (*sic.*) 69-75, and 82-95 are rejected under 35 U.S.C. 112, first paragraph, for lack of enablement for the reasons set forth in the prior Office action mailed December 19, 2003.

Upon entry of the amendment, claims 69-75, 82, 83, and 100-108 overcome this rejection, whereas claims 84-95 and 109-119 will be rejected.

The claims that "will be rejected", claims 84-95 and 109-119, have been canceled by the present amendment. Thus, this ground for rejection is now moot and should be withdrawn.

35 U.S.C. § 112, ¶ 2

Claims 84-95 were rejected as being indefinite. In the Advisory Action, however, the Examiner states, "[u]pon entry of the amendment filed January 27, 2005, this rejection will be obviated" (Advisory Action at page 3).

With the filing of the RCE, the after-final amendment should now be entered and should, as the Examiner stated, obviate the rejection of claims 84-95, which are canceled by the present amendment. Thus, the rejection based on lack of clarity should now be withdrawn.

Applicant : Vimla Band
Serial No. : 10/021,368
Filed : December 12, 2001
Page : 10 of 10

Attorney's Docket No.: 00398-100005

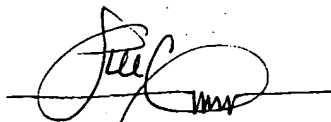
CONCLUSION

In view of the submission of the Terminal Disclaimer and the amendments that should now be entered, Applicant contends the present claims are now in condition for allowance, which action is respectfully requested.

A \$65 check for the Terminal Disclaimer fee required under 37 C.F.R. §1.20(d); a \$510 check for a 3--month petition for extension of time; and a \$395 check for the RCE fee required under 37 C.F.R. §1.114 are enclosed. Any other necessary charges or credits can be applied to Deposit Account No. 06-1050, with reference to Attorney Docket No. 00398-100005.

Respectfully submitted,

Date: August 22 2005



Lee Crews, Ph.D.
Reg. No. 43,567

Fish & Richardson P.C.
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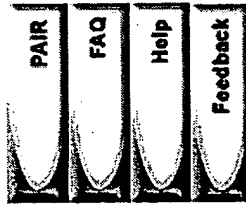


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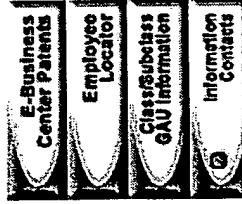
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Search results for application number:09/201,038			
Application Number:	09/201,038	Customer Number:	-
Filing or 371(c) Date:	11-30-1998	Status:	Patented Case
Application Type:	Utility	Status Date:	11-09-2000
Examiner Name:	NASHED, NASHAAT T	Location:	FILE REPOSITORY (FRANCONIA)
Group Art Unit:	1652	Location Date:	04-26-2005
Confirmation Number:	1057	Earliest Publication No:	-
Attorney Docket Number:	00398/100003	Earliest Publication Date:	-
Class/ Sub-Class:	435/006	Patent Number:	6,153,387
First Named Inventor:	VIMLA BAND, NATICK, MA (US)	Issue Date of Patent:	11-28-2000
Title Of Invention: NES-1 POLYPEPTIDES, DNA, AND RELATED MOLECULES AND METHODS			

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Parent Continuity Data		
Description	Parent Number	Parent Filing or 371(c) Date
		Parent Status

This application is a Continuation of	08/628,198	04-05-1996	Patented
Which is a Division of	08/467,155	06-06-1995	Patented
Child Continuity Data			
09/605,175 filed on 06-28-2000 which is Abandoned claims the benefit of 09/201,038			
10/021,368 filed on 12-12-2001 which is Pending claims the benefit of 09/201,038			

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